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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,961

12/03/2003

Eric C. Erike

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7590

04/08/2009

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EXAMINER

MCGUTHRY BANKS, TIMA MICHELE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

04/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,961	<b>Applicant(s)</b> ERIKE, ERIC C.	
	<b>Examiner</b> TIMA M. MCGUTHRY-BANKS	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,7 and 10 is/are allowed.
- 6) ☒ Claim(s) 1,3,9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1 and 9 are currently amended, claims 2, 4, 6 and 8 are cancelled, Claim 3 is as originally filed, and Claims 5, 7 and 10 are as previously presented.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/25/2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyooka et al (US 6,290,789 B1).

Toyooka et al is applied as discussed in the office action mailed 10/20/2008. Regarding the limitation "cold-drawing," this limitation implies a product by process. Since the prior art reads on the structure, then the burden shifts to the applicant to show an unobvious difference.

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See MPEP § 2113. Toyooka et al teaches substantially the same induction heated low carbon steel tube as in the instant claims.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyooka et al as applied to claim 1 above, and further in view of Kondo et al (US 6,024,808).

Toyooka et al in view of Kondo et al is applied as discussed in the office action mailed 9 July 2008.

#### ***Allowable Subject Matter***

Claims 5, 7 and 10 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the indication of allowable subject matter is set forth in the office action mailed 10/20/2008.

#### ***Response to Arguments***

Applicant's arguments filed 2/25/2009 have been fully considered but they are not persuasive. Applicant argues that the composition of Toyooka et al is not substantially similar or identical to the composition recited in Claim 1. The composition range of Toyooka et al overlaps S and Si, but the remaining ranges are encompassed within the broader range of Toyooka et al. Therefore, the composition is substantially similar, since Toyooka et al reads on those overlapping ranges. "[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness." See MPEP § 2144.05 I. Applicants can rebut a *prima facie* case of obviousness based on

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overlapping ranges by showing the criticality of the claimed range, showing that the art, in any material respect, teaches away from the claimed invention. See MPEP § 2144.05 III. Regarding the argument with respect to the tensile strength in Claim 1, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding the process in which the apparatus is made, determination of patentability is based on the product itself. Regarding Claim 3, the art of mechanical testing for steel teaches two types of tensile strength determinations: static and dynamic, or high speed. Applicant does not distinguish in the disclosure the type of tensile strength test performed. The examiner recognizes the allowability of the method of Claims 5, 7 and 10. However, the examiner maintains that the apparatus as claimed in Claims 1, 3 and 9 are not distinguishable over the cited prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMA M. MCGUTHRY-BANKS whose telephone number is (571)272-2744. The examiner can normally be reached on M-F 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Wyszomierski/  
Primary Examiner  
Art Unit 1793

/T. M. M./  
Examiner, Art Unit 1793  
8 April 2009